

REMARKS/ARGUMENTS

The Office Action mailed January 7, 2008 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Claims 1, 39, 42, 48, 54, and 57 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for these changes may be found in the specification and figures.

Rejection Under 35 U.S.C. §103

Claims 1-13, 23-26, 28-30 and 39-64 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,776,158 to Anderson et al. ('Anderson') in view of US Patent No. 4,520,808 to LaBauve ('LaBauve'). This rejection is respectfully traversed. Claims 1, 23, 39, 42, 45, 48, 54, 57, and 60 are independent claims.

According to the Manual of Patent Examining Procedure (M.P.E.P.) § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Anderson except that "Anderson does not expressly disclose the particulars of the first gas delivery outlet to be able to deliver gas to a plurality of living specimens." The Office Action further contends that "the particular structure of the gas delivery outlet device was well known" and cites to LaBauve as teaching "a gas deliver device for holding multiple laboratory animals horizontally disposed along a front face of the gas delivery device and capable of simultaneously providing anesthesia gas and oxygen to the multiple laboratory animals". The Office further states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Anderson to include the particular structural elements of the first gas delivery outlet device, as taught by

LaBauve to enable uniform distribution of anesthesia gas to the laboratory animals.” The Applicants respectfully disagree for the reasons, among others, set forth below.

a. Independent Claims 1, 39, 42, 48, 54, and 57

The alleged combination of Anderson and LaBauve does not teach each and every single element of the claimed invention. Amended Claim 1 provides for “at least one hole disposed on the front face adjacent to the multiple living specimen interfaces capable of drawing in anesthesia gas.” Amended Claims 39, 42, 48, 54, and 57 provide for similar features.

Neither Anderson nor LaBauve teach having “at least one hole disposed on the front face adjacent to the multiple living specimen interfaces capable of drawing in anesthesia gas” as claimed in Claim 1. Rather, LaBauve teaches the use of “a plurality of exhaust vents located around animal holding tube means 12.” (Col. 4, lines 31-32). As such, LaBauve does not teach having the exhaust vents on the same surface as the atmosphere inlet means and as such does not teach “at least one hole disposed on the front face adjacent to the multiple living specimen interfaces capable of drawing in anesthesia gas” as claimed in Claim 1.

Additionally, Claims 1, 39, and 42 provide for “a gas delivery device having multiple living specimen interfaces horizontally disposed along a front face of the gas delivery device.” The Office Action states that “there are no structural characteristics that prevent the device of LaBauve to be oriented in the recited fashion providing the animal holding receptacles (12) in a horizontally displaced orientation along the front of the gas delivery system. ... In this case, as gases are being delivered to the mice, the device is fully capable of operating whether upright on its side.” Applicants respectfully disagree.

The Examiner is alleging that the device of LaBauve may easily be turned “on its side” such that the tubes are in a horizontal position. However, the “mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). No wherein does LaBauve teach, suggest, or discuss the ability to use the device “on its side”.

Furthermore, it “is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is

rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *Id.*, 23 USPQ2d 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)). Rather, such a motivation has been given by the applicant who first realized the problems presented and discovered a viable solution. Using the applicant’s teaching to modify a prior art reference is an impermissible use of “hindsight.” *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997).

Additionally, the alleged combination of Anderson and LaBauve is not possible as the proposed modification would render the prior art (Anderson) unsatisfactory for its intended purpose (See, MPEP §2143.01). The Office Action alleges that the device of LaBauve may be used as a substitute for the “solo apparatus” of Anderson which is used to “administer anesthetic to a single animal ... [which has a base that] may be formed with different dimensions and geometries depending in the particular species of animal used and the type of procedure being performed.” (Col. 4, lines 55-67 through Col. 5, lines 1-3). Thus, the solo apparatus of Anderson is used to continuously administer anesthetics to a single animal during a surgical procedure. Should the device of LaBauve be used, the user would not be able to perform any surgical procedures on the animal as the animal is in a holding tube means (reference 12 of LaBauve). Furthermore, should the animal be taken out to perform the surgery, the animal would not be continuously anesthetized to keep the animal asleep. Thus, the alleged combination would render Anderson unsatisfactory for its intended purpose.

Accordingly, the combination of prior art references do not teach each and every claim element, there is no motivation in the prior art reference to combine the references to obtain the modification as suggested by the Examiner, and the combination of prior art references would render the prior art unsatisfactory for its intended purpose.

b. Claims 23 and 45

Claim 23 provides for “a vertical slot disposed between two adjacent specimen interfaces, wherein the vertical slot is capable of receiving and holding an opaque light barrier ... and b) an opaque light barrier for insertion in the vertical slot.” Claim 45 provides for similar features. The Office Action fails to point out specifically where in Anderson or LaBauve that teaches the use of “a vertical slot disposed between two adjacent specimen interfaces” and “an opaque light barrier for insertion in the vertical slot”. The Office Action simply states that “LaBauve teaches the gas

delivery apparatus can [be] made of numerous materials based upon the desires of the designed including glasses, plastics, and metal alloys.” However, nowhere in the Office Action does it specifically show that Anderson or LaBauve provides for the features and in fact, neither Anderson nor LaBauve teach the use of vertical slots or opaque light barriers inserted in the vertical slots”. Should the Examiner maintain this rejection, it is respectfully requested that a specific citation be provided as to where Anderson or LaBauve teach a vertical slot disposed between two adjacent specimens to receive an opaque light barrier. Thus, a *prima facie* case of obviousness has not been made.

Additionally, the alleged combination of Anderson and LaBauve is not possible as the proposed modification would render the prior art (Anderson) unsatisfactory for its intended purpose (See, MPEP §2143.01). The Office Action alleges that the device of LaBauve may be used as a substitute for the “solo apparatus” of Anderson which is used to “administer anesthetic to a single animal ... [which has a base that] may be formed with different dimensions and geometries depending in the particular species of animal used and the type of procedure being performed.” (Col. 4, lines 55-67 through Col. 5, lines 1-3). Thus, the solo apparatus of Anderson is used to continuously administer anesthetics to a single animal during a surgical procedure. Should the device of LaBauve be used, the user would not be able to perform any surgical procedures on the animal as the animal is in a holding tube means (reference 12 of LaBauve). Furthermore, should the animal be taken out to perform the surgery, the animal would not be continuously anesthetized to keep the animal asleep. Thus, the alleged combination would render Anderson unsatisfactory for its intended purpose.

As such the combination of prior art references do not teach all the claimed elements, the combination would render the prior art unsatisfactory for its intended purposes, and a *prima facie* case of obviousness has not been met.

c. Claim 60

Claim 60 provides for “a mouse interface including a hole in the front face, wherein the mouse interface is sized to at least partially receive the head of the mouse and to provide the anesthesia gas and oxygen in a first direction; ... at least one hole in the front face adjacent to the mouse interface and capable of drawing in anesthesia gas in a second direction that is opposite to the first direction.”

The Office Action states “LaBauve teaches the gas is delivered in a first direction (from the source in nose of the mouse) and removed in a second direction (from the nose of the mouse out to the vacuum). (Figure 1). Intrinsically, the device of LaBauve is capable of providing the directionality of the gases to be administered and to be removed from the mouse in opposite manner.” Applicants respectfully disagree.

First, upon a closer reading of LaBauve and review of Figure 1, the arrows clearly show the flow of gasses in the same direction. (See, Col. 1, lines 14-15). As stated above, the “mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). No wherein does LaBauve teach, suggest, or discuss providing opposite flow directions.

Furthermore, it “is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention’” *Id.*, 23 USPQ2d 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)). Rather, such a motivation has been given by the applicant who first realized the problems presented and discovered a viable solution. Using the applicant’s teaching to modify a prior art reference is an impermissible use of “hindsight.” *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997).

Second, the “at least one hole” is positioned “in the front face adjacent to the mouse interface and capable of drawing in anesthesia gas.” On the other hand, LaBauve teaches the use of “a plurality of exhaust vents located around animal holding tube means 12.” (Col. 4, lines 31-32). As such, LaBauve does not teach having the exhaust vents on the same surface as the atmosphere inlet means and as such does not teach “at least one hole in the front face adjacent to the mouse interface and capable of drawing in anesthesia gas” as claimed in Claim 60.

Last, the alleged combination of Anderson and LaBauve is not possible as the proposed modification would render the prior art (Anderson) unsatisfactory for its intended purpose (See, MPEP §2143.01). The Office Action alleges that the device of LaBauve may be used as a substitute for the “solo apparatus” of Anderson which is used to “administer anesthetic to a

single animal ... [which has a base that] may be formed with different dimensions and geometries depending in the particular species of animal used and the type of procedure being performed.” (Col. 4, lines 55-67 through Col. 5, lines 1-3). Thus, the solo apparatus of Anderson is used to continuously administer anesthetics to a single animal during a surgical procedure. Should the device of LaBauve be used, the user would not be able to perform any surgical procedures on the animal as the animal is in a holding tube means (reference 12 of LaBauve). Furthermore, should the animal be taken out to perform the surgery, the animal would not be continuously anesthetized to keep the animal asleep. Thus, the alleged combination would render Anderson unsatisfactory for its intended purpose.

Accordingly, for at least the reasons above, it can not be said that the alleged combination of Anderson and LaBauve anticipates the claimed invention. As to dependent Claims 5-10, 12-13, 24-26, 28-30, 40, 43-44, 46-47, 49-50, 55-56, 58-59, and 61, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable. It is respectfully requested that this rejection be withdrawn.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited and Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant hereby petitions for an extension of time that may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 50-4481 (Order No. XENOP008).

Respectfully submitted,
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